

## **REMARKS**

The above amendments and these remarks are responsive to the Office action dated May 16, 2006. As an initial matter, Applicants thank the Examiner for his time during a telephone conference with Applicants' attorney on Tuesday, July 18, 2006, discussing the status of the present application.

The present application was filed on November 17, 2003. In a first Office action dated September 2, 2005, the Examiner issued a restriction requirement between claims 1-18 and 19-23. In their response dated March 1, 2006, Applicants elected claims 1-18. In the same paper, Applicants also submitted amendments to claims 1-18; however, the claims 1-18 submitted correspond to the present application's parent application with Serial No. 10/359,018. In other words, Applicants inadvertently submitted an incorrect set of amended claims together with their response to the Examiner's restriction requirement.

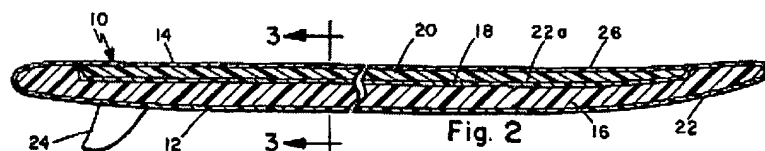
In the second Office action dated May 16, 2006, the Examiner noted that "amended claims 1-18 do not correspond to applicant's originally filed claims 1-18." [OA ¶ 1]. The Examiner examined the amended claims 1-18 because the amendment "[did] not contain new matter." [*Id.*] Applicants presently continue to prosecute the amended claims 1-18 and have added the original claims 1-18 as new claims 24-40. Accordingly, in the above listing, claims 1-18 are indicated as "Previously presented" rather than original, even where no additional amendments are presently made, and claims 24-40 are indicated as "New" even where Applicants have amended them from the originally filed claims 1-18.

In the Office action, the Examiner rejected claims 1-18 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,129,911 to McDonald et al. ("McDonald") in view of U.S. Patent No. 4,062,711 to Davis ("Davis"). Applicants traverse the rejections. In view of the amendments above, and the remarks below, Applicants respectfully request reconsideration of the application under 37 C.F.R. § 1.111 and allowance of the pending claims.

### **Rejections under 35 USC § 103**

Applicants have studied the cited references in view of the pending claims and the reasons expressed in the Office action. Applicants respectfully disagree that the subject matter of claims 1-18 is rendered obvious by the cited references, alone or in combination, and Applicants request reconsideration of the rejections for at least the reasons discussed below.

First, McDonald does not disclose "cutting an aperture out of a first laminate sheet [and] cutting a congruent insert from a second laminate sheet to be placed in the aperture of the first laminate sheet," as required by independent claim 1 and similarly required by independent claim 11. McDonald discloses a sports board with a lower body 16 coated with a fiberglass coating 22, and an upper body 20 that is shaped to fit within a cavity 18 of the lower body, and is covered with an outer vinyl coating 26, as shown in Fig. 2 below. The fiberglass coating 22 includes a portion 22a positioned within the cavity 18.

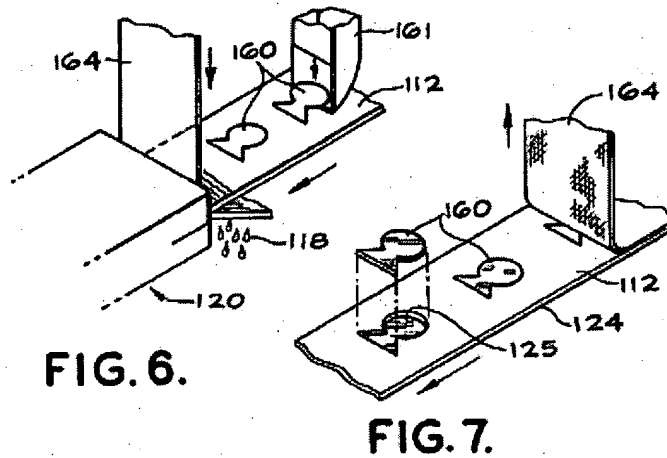


The Examiner appears to contend that the insert 20 of McDonald is the same as Applicants' "congruent insert from a second laminate sheet," thus requiring lower body 16 of McDonald to be the same as Applicants' "first laminate sheet." However, both insert 20 and lower body 16 of McDonald are "constructed of a suitable lightweight strong flotation material such as plastic foam." (Col. 2, lines 16-18). Therefore, neither insert 20 nor lower body 16 is, or is cut from, a laminate sheet.

McDonald does state that "[t]he lower body member 16 is then covered with laminations of fiberglass cloth and polystyrene resin." However, the covering of the lower body member 16 does not amount to "cutting an aperture out of a first laminate sheet [and] cutting a congruent insert from a second laminate sheet to be placed in the aperture of the first laminate sheet."

Likewise, Davis fails to disclose "cutting an aperture out of a first laminate sheet [and] cutting a congruent insert from a second laminate sheet to be placed in the aperture of the first laminate sheet." The Examiner states that "[a]s shown in Figs. 6-11, flat members 160 are placed in depression 125 of mat 112. Die 120 then laminates the materials to form structure 124." [OA ¶ 3]. Applicants have studied Davis and respectfully disagree with the Examiner. As discussed at column 5, line 48 through column 6, line 14, and as shown in Figs. 6 and 7 reproduced below, Davis discloses the placing of flat members 160 on the top surface of fiber mat 112, covering mat 112 with cover sheet 164, and feeding the assembly into forming die 120. Upon passing through forming die 120, the flat members 160 are removed and a *depression* is left where the flat members were formerly placed. No cutting of laminate sheets is disclosed, let alone

"cutting an aperture out of a first laminate sheet [and] cutting a congruent insert from a second laminate sheet to be placed in the aperture of the first laminate sheet."



Accordingly, neither McDonald nor Davis, either standing alone or in any permissible combination thereof teach or suggest each and every limitation of independent claim 1.

In the Office Action, the Examiner states that "the specific insert/aperture pattern and the materials used are well known and conventional in the art and would have been obvious to employ." [OA ¶ 3]. Applicants traverse what appears to be an official notice taken by the Examiner. "As noted by the court in *In re Ahlert*, the notice of facts beyond the record which may be taken by the examiner must be 'capable of such instant and unquestionable demonstration as to defy dispute.'" MPEP § 2144.03(A) (internal citations omitted). "If the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding." MPEP § 2144.03(C).

**Conclusion**

Applicants believe that this application is now in condition for allowance in view of the above amendments and remarks. Accordingly, Applicants respectfully request that the Examiner issue a Notice of Allowability covering the pending claims. If the Examiner has any questions, or if a telephone interview would in any way advance prosecution of the application, please contact the undersigned attorney of record.

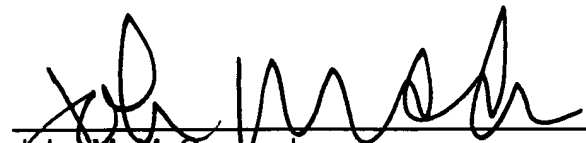
**CERTIFICATE OF MAILING**

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, to: Mail Stop AMENDMENT, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450 on August 30, 2006.

  
Heidi Dutro

Respectfully submitted,

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